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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,262	09/11/2003	Takahiro Moro	00862.001703.2	3540
5514	7590	12/21/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			POON, KING Y	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/659,262	Applicant(s) MORO ET AL.	
	Examiner King Y. Poon	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59,61-66,68-72 and 74-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 59,61-66,68-72 and 74-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/768,579.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/30/2005 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 78, 79, 80 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 78, 79, 80: The limitations "wherein, if change instruction by the user is required, the changing unit changes the set value of the second setting item without the change instruction, otherwise the changing unit changes the set value of the

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second setting item in response to the change instruction” is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 78-80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 78-80: Claims 78-80 depend on claims 72, 59, 66 respectively. Claims 72, 59, 66 requires: if user instruction is required, the value of the second setting item is changed with the change instruction. Claims 78-80 is claiming: if user instruction is required, the value of the second setting item is changed without the change instruction. The applicant is required to clarify what is being claimed. I.e., if user instruction is required, the value of the second setting item is changed with the change instruction or if user instruction is required, the value of the second setting item is changed without the change instruction.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 59, 61-66, 68-72, 74-77, 81-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al (US 5,006,895).

Regarding claims 59, 66: Hashimoto teaches an information processing apparatus (host computer with a input matrix, decoder and a display, column 7, lines 20-30) connected (fig. 5) with a printing device (column 7, lines 30-45), comprising: a display unit (e.g., fig. 3) adapted to display a setting window including a set value (e.g., selecting a book size/scanning size, column 9, lines 1-10) of a first setting item (book size/scanning size) for printing and a set value of a second setting item (selected size of paper, column 6, lines 18-24) for printing; a determination unit S21, S 30, fig. 8B) adapted to, when the set value of the first setting item displayed in the setting window is changed into a second value from a first value (e.g., A4, B5, A5, etc, fig. 4) determine whether or not a change instruction by a user is required (user's instruction is required in AMS mode to change paper size which is not required in APS mode) if desirable to change a third value of the second setting item for printing displayed in the setting window, in association with the change into the second value, (it is always desirable to change the value of display to reflect the correct paper selected for printing selected by the user, e.g., fig. 10A and 10B, and it is always desirable to select different paper for different original in order to have the desired magnification, column 6, lines 42-52) and a changing unit (the program of fig. 8A, and 8B, 9A, 9B, 10A, 10B except S21 and S30) adapted to, when determined by said determination unit that the change instruction by

the user is not required, change the set value of the second setting item into a fourth value from a third value without a change instruction made by the user (column 9, lines 50-60), and adapted to when determined by said determination unit that the change instruction by the user is required, change the set value of the second setting item into the fourth value from the third value in response to a change instruction made by the user (column 11, lines 32-42).

Hashimoto does not teach user change the third value of the second setting item in accordance with the second value of the first setting item.

However, as previously discussed, the step S29 is telling the most suitable size paper size to the user in copying the original size (in accordance with the second value of the first setting item) if the paper is not being set in the paper cassette; it would have been obvious to a person (user) with ordinary skill in the art at the time the invention was made to set the paper size in accordance with the second value of the first setting item (the original size) after replacing the correct size of paper in the cassette after the user printing other copy job using the paper in the cassette before the paper is being replaced using AMS mode.

Regarding claims 61, 68: Hashimoto teaches wherein the changing unit displays an operation window (fig. 3) for the change instruction made by the user and changes (S31) the second setting item display in the setting window into the fourth value from the third value if determined that the user makes the change instruction to change the value of the second setting.

Regarding claims 62, 69: Hashimoto teaches wherein the changing unit does not change the third value of the second setting item for printing display in the setting window if not determined that the user makes the change instruction (the setting would not be changed is user does not use S31, fig. 8B, in AMS mode) to change the value of the second setting item.

Regarding claims 63: Hashimoto teaches the information processing apparatus comprising a host computer (column 7, line 24).

Regarding claims 64, 70: Hashimoto teaches wherein the first setting item and the second setting item include a setting of the printing device (column 7, lines 30-45).

Regarding claims 65, 71: Hashimoto teaches wherein the first setting item includes a setting for a medium (scanning medium, original, column 9, lines 1-10) and the second setting item includes a setting for a printing method (using a particular paper for printing, S29, fig. 8B).

Regarding claims 72, 74, 75, 76, 77: Claim 72, 74, 75, 76, 77 are claiming a computer readable medium for storing a program code for the system and method discussed in claims 59, 61, 62, 64, 65. Hashimoto teaches the invention of claims 59, 64, 65, 66, 70, 71 are written in a program (column 10, line 58; also see routine of column 8, lines 45-46). Inherently, all program codes are stored in a computer readable memory.

Regarding claims 82-84: Hashimoto teaches an information processing apparatus (host computer with a input matrix, decoder and a display, column 7, lines 20-30) connected (fig. 5) with a printing device, (column 7, lines 30-45) comprising: a

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display unit (e.g., fig. 3) adapted to display a setting window including a set value (e.g., selecting a book size/scanning size, column 9, lines 1-10) of a first setting item (book size/scanning size) for printing (the scan size determines what is being printed) and a set value of a second setting item (selected size of paper, column 6, lines 18-24) for printing; a changing step adapted to, when the set value of the first setting item displayed in the setting window is changed into a second value from a first value (column 9, lines 1-10), not change a third value of the second setting item, displayed in the setting window for printing, if determined to not be required to change the third value of the second setting item in association with the changed second value of the first setting item (A3 paper size would not change when origin changed from A4 to B5 and magnification changed from 1.414 to 1.154, column 6, lines 40-56), adapted to, when the set value of the first setting item displayed in the setting window is changed into the second value from the first value, change the set value of the second setting item displayed in the setting window into a fourth value from the third value without a change instruction made by a user if determined to be desirable to change the third value of the second setting item in association with the second value of the first setting item, for printing (column 9, lines 50-60), and adapted to, when the set value of the first setting item displayed in the setting window is changed into the second value from the first value, change the set value of the second setting item displayed in the setting window into the fourth value from the third value in response to a change instruction made by a user if determined to be desirable to change the third value of the second setting item in

accordance with the second value of the first setting item, for printing (column 11, lines 32-42).

Hashimoto does not teach user change the third value of the second setting item in accordance with the second value of the first setting item.

However, as previously discussed, the step S29 is telling the most suitable size paper size to the user in copying the original size (in accordance with the second value of the first setting item) if the paper is not being set in the paper cassette; it would have been obvious to a person (user) with ordinary skill in the art at the time the invention was made to set the paper size in accordance with the second value of the first setting item (the original size) after replacing the correct size of paper in the cassette after the user printing other copy job using the paper in the cassette before the paper is being replaced using AMS mode.

Regarding claims 85-86: Claims 85-86 are claiming a computer readable medium for storing a program code for the system and method discussed in claims 83, 84. Hashimoto teaches the invention of claims 83, 84 are written in a program (column 10, line 58; also see routine of column 8, lines 45-46). Inherently, all program codes are stored in a computer readable memory.

Response to Arguments

8. Applicant's arguments filed 9/30/2005 have been fully considered but they are not persuasive.

With respect to applicant's argument regarding the 112 first rejection for claims 78, 79, 80, has been considered.

In reply: As pointed out by the applicant on page 15 of the remarks that "it is determined whether the selection of the setting, i.e., change of the second setting item, should be made by the user. If so, the second setting is changed in accordance with an instruction by the user. The examiner agrees with the applicant. Therefore, the limitation of "it is determined whether the selection of the setting, i.e., change of the second setting item, should be made by the user. If so, the second setting is NOT changed in accordance with an instruction by the user" is not being disclosed by the specification.

With respect to applicant's argument that the Hashimoto does not teach user given instruction to change a setting such as paper setting when another setting such as original sized is changed; has been considered.

In reply: column 11, lines 32-42 teaches a user to give instruction to change a paper size.

Hashimoto does not teach user change the third value of the second setting item in accordance with the second value of the first setting item.

However, as previously discussed, the step S29 is telling the most suitable size paper size to the user in copying the original size (in accordance with the second value of the first setting item) if the paper is not being set in the paper cassette; it would have been obvious to a person (user) with ordinary skill in the art at the time the invention was made to set the paper size in accordance with the second value of the first setting

item (the original size) after replacing the correct size of paper in the cassette after the user printing other copy job using the paper in the cassette before the paper is being replaced using AMS mode.

With respect to applicant's argument that the Hashimoto does not teach: when set value of a first setting item displayed in a setting window is changed into a second value from a first value, not changing a third value of a second setting item, displayed in the setting window for printing, if determined to not be required to change the third value of the second setting item in association with the changed second value of the first setting; has been considered.

In reply: Hashimoto teaches when the set value of the first setting item displayed in the setting window is changed into a second value from a first value (column 9, lines 1-10), not change a third value of the second setting item, displayed in the setting window for printing, if determined to not be required to change the third value of the second setting item in association with the changed second value of the first setting item (A3 paper size would not change when origin changed from A4 to B5 and magnification changed from 1.414 to 1.154, column 6, lines 40-56).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 12, 2005

A handwritten signature in black ink, appearing to read 'K. Y. Poon', with a stylized flourish at the end.

KING Y. POON
PRIMARY EXAMINER